

Attorney's Docket No. 044276/242574 (5854-6)

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: **Kappes et al.** Confirmation No.: 1101  
Appl No.: 10/019,644 Group Art Unit: 1648  
Filed: 7/6/00 Examiner: B. Li  
For: RETROVIRAL RECOMBINATION ASSAYS AND USES THEREOF

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated October 6, 2003, in which the Examiner has required restriction between Group I, namely Claims 1-32, Group II, namely Claims 33-39, Group III, namely Claims 40-51 and 59 and Group IV, namely Claims 52-58. Applicant hereby provisionally elects with traverse to prosecute the claims of Group I (Claims 1-32) and expressly reserves the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims.

The Examiner further requires an election of species. Specifically, the Examiner identified 4 species elections if Group I was elected. As outlined in the accompanying Preliminary Amendment, claims 6-8, 11 and 17-59 have been canceled and claim 60 has been added. Applicants assume newly added claim 60 would be grouped into Group III. In view of the amendments to the claims of Group I, a species election for a "method of detecting" is the only species election at issue. Applicants elect the species drawn to a "mobilization" based detection assay.

Applicants respectfully request the Examiner to reconsider the Restriction Requirement and regroup Group I and Group III. The Examiner asserts that the inventions of Groups I to IV do not relate to a single inventive concept under PCT Rule 13.1 because they lack a novel corresponding special technical feature. Specifically, the Examiner concludes the common technical feature comprises a method for detecting a retrovirus recombinant by using one or more helper functions to permit the detection of the recombinant and cites Kafri *et al.* (1999) *Journal of Virology* 73:576-584 as teaching this technical feature. Applicants disagree with this conclusion regarding Kafri *et al.*, however, Applicants will not address the cited prior art at this time as the standard for Unity of

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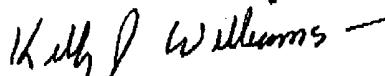
Invention between Group I and Group III has been resolved by making claim 60 of Group III dependant on claim 1 of Group I.

As the subject matter of claim 60 falls within claim 1, no objection arise under Rule 13.1. See, the Draft International Search and Preliminary Examination Guidelines (December 15, 2003) at [www.wipo.int/pct/en/texts/pdf/pct\\_g1\\_ispe\\_1\\_prov2.pdf](http://www.wipo.int/pct/en/texts/pdf/pct_g1_ispe_1_prov2.pdf), Chapter 10, section 0.6, page 76 which states "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." As such, the Examiner is respectfully requested to reconsider the Restriction Requirement and allow Groups I and III to be examined together.

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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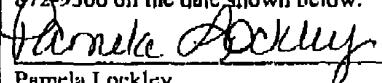
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**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.



Pamela Lockley

February 6, 2003

Date

RTA01/314M000V1